PATENT

Atty Docket No.: 10003526-1
App. Ser. No.: 09/843,930

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks. Claims 1-10 and 12-22 are pending in the present application of which claims 1, 10 and 19 are independent. Claim 11 has been canceled and the features of claim 11 have been combined with independent claim 10 to place claims 10, 12-18 and 22 in condition for allowance.

Claims 1-10 and 19-22 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Lee et al. ("An Analytic Performance Model of Disk Arrays", SIGMETRICS, 1993, pages 98-109) ("Lee et al.").

Claims 1, 4-6, 9-10 and 19-22 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Shriver et al. ("An Analytic Behavior Model for Disk Drives with Readahead Caches and Request Reordering", SIGMETRICS, 1998, pages 182-191) ("Shriver et al.") or Lynch et al. (U.S. Patent No. 6,002,854) ("Lynch et al.").

Claims 2-3 and 7-8 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shriver et al. or Lynch et al. in view of Lee et al.

These rejections are respectfully traversed for at least the following reasons.

Claims 11-18 were objected to as including allowable subject matter but being dependent on a rejected base claim.

Examiner Interview Conducted

A telephonic interview was conducted with Examiner Jones on July 1, 2005. It was agreed that the amendments herein place the application in condition for allowance and the application would be allowed by filing the amendments in an amendment after final.

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Claim Rejection under 35 U.S.C. 102

The test for determining if a reference anticipates a claim, for purposes of a rejection under 35 U.S.C. § 102, is whether the reference discloses all the elements of the claimed combination, or the mechanical equivalents thereof functioning in substantially the same way to produce substantially the same results. As noted by the Court of Appeals for the Federal Circuit in *Lindemann Maschinenfabrick GmbH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984), in evaluating the sufficiency of an anticipation rejection under 35 U.S.C. § 102, the Court stated:

> Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.

Therefore, if the cited reference does not disclose each and every element of the claimed invention, then the cited reference fails to anticipate the claimed invention and, thus, the claimed invention is distinguishable over the cited reference.

The Office Action sets forth a rejection of claims 1-10 and 19-22 under 35 U.S.C. § 102(b) as being allegedly anticipated by Lee et al. Also, claims 1, 4-6, 9-10 and 19-22 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Shriver et al. or Lynch et al.

It was agreed in the Examiner interview that the features of independent claims 1, 10 and 19 as amended herein are not taught by the prior art. In particular, it was agreed the prior art fails to teach or suggest all three types of claimed models in independent claims 1 and 19. Also, independent claim 10 has been amended to include features of claim 11, whereby claim 11 was indicated by the Examiner as including allowable subject matter.

Accordingly, claims 1-10 and 12-22 are believed to be allowable.

Claim Rejection Under 35 U.S.C. §103

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in MPEP § 706.02(j):

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s).

Claims 2-3 and 7-8 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shriver et al. or Lynch et al. in view of Lee et al. Claims 2-3 and 7-8 are believed to be allowable for at least the reasons their corresponding independent claims are believed to be allowable.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited. Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed

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below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: July 22, 2005 By

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